REMARKS

Claims 51 – 66 have been amended. Claims 1 – 66 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 101 Rejection:

The Examiner newly rejected claims 51-66 under 35 U.S.C. § 101 as not limited to tangible embodiments. **Applicants note that this rejection constitutes a new ground of rejection not necessitated by any amendment. Accordingly, the Office Action cannot properly be made final.** *See* M.P.E.P. § 706.07(a). Pursuant to M.P.E.P. § 706.07(d), Applicants assert that due to this new ground of rejection, the finality of the current Action is premature. Applicants request withdrawal of the finality of the current Action.

Claims 51 – 66 have been amended to recite a tangible computer accessible medium. As such, Applicants respectfully request removal of this rejection.

Section 103(a) Rejection:

The Examiner rejected claims 1, 5, 10, 13, 14, 16-21, 24-26, 44-46, 50, 51, 54, 58-63, 65 and 66 as being unpatentable over Buckle (UK Patent 2,332,288) in view of Wolff (U.S. Patent 6,668,271). Applicants traverse this rejection for at least the following reasons.

In regard to claim 1, contrary to the Examiner's assertion, Buckle in view of Wolff fails to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state and storing the data representation language representation of the current computation state of the process. Buckle discloses a method in which "it is possible to transmit *binary files or byte code* between agents. The byte code sent in a message may include byte code of an

agent itself. Buckle's agent enabling layer utilizes the CORBA Externalization service to record object and object states (i.e. an agent) as a stream of data" (Buckle, page 38, lines 12-14). Thus, Buckle teaches that the *binary* byte code of an agent may be included in a message from a location L1 to a location L2. Wolff teaches a network appliance system in which agent cards include state information for functionality and which can be mounted in an agency unit (Wolff, Abstract, FIG. 1, column 1, lines 20-29, and column 2, lines 28-36).

In contrast to the Examiner's assertion, Buckle does not teach or suggest storing the data representation language representation of the current computation state of the process. Instead, Buckle teaches that the "agent *code*... is stored locally at ... location L2, so that the *agent can operate* at physical location L2." (Emphasis added, Buckle, col. 39, lines 4-8). The Examiner equates this storing of agent *code* to storing a *representation* of the current computation state of a process. However, Applicants point out that Buckle specifically refers to storing the agent *code* and that this storing enables the agent *to operate.* Thus, Buckle cannot be saving a *representation* of the current computation state. Firstly, it is clearly binary code. Secondly, a *representation* of an agent, rather than the actual agent code, would not be able to operate as required by Buckle without further conversion into the agent's actual byte code.

Buckle teaches that the actual byte code of an agent (which is not a data representation language representation) is sent to another location as the content parameter of an ACL message. The Examiner admits that Buckle fails to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state. The Examiner relies upon Wolff, citing column 2, lines 1-10, column 3, lines 25-45, column 4, lines 25-35, column 5, lines 1-8, and column 6, lines 1-5. The first cited passage (column 2, lines 1-10) generally describes how IP address and URL names are used with the Internet. The other cited passages describe various aspects of how Wolff's agent cards work.

However, the combination of Buckle and Wolff does not teach or suggest Applicants' claimed invention. Wolff's agent cards do not suggest modifying Buckle's CORBA-based agent mobility system. Wolff teaches that agent cards maintain state for their functionality, but can be physically moved from agency unit to agency unit (Wolff, column 3, lines 6-7). In other words, Wolff's system requires physically moving agent cards from one agency unit to another. Buckle, on the other hand, teaches that binary agent code may be sent from one location to another via ACL messages. Wolff's system does not involve, nor is Wolff concerned with transferring state information for a process from one device to another, but instead involves allowing devices, that may contain state information to be moved from one physical location to another physical location, i.e. from one of Wolff's agency units to another. The operation of Wolff's agent card clearly would not apply to the binary agent code transfer in Buckle's system.

In response to Applicants' argument above, the Examiner argues that Wolff was not cited alone, but that Buckle teaches converting the current state of a process into "a language of the current process" citing page 38 and referring to Buckle's use of an ACL message stream to record object states. However, as noted above, Applicants clearly argue that **Buckle in view of Wolff** fails to teach converting a current computation state of a process into a data representation language representation of the current computation state. Additionally, as also noted above, Buckle teaches transferring executable binary or byte code using ACL messages and that Buckle's system is incompatible with data representation language representations of computational states. The Examiner's hypothetical combination of Buckle and Wolff does not teach converting a current computation state of a process into a data representation language representation of the current computation state.

In response to Applicants' argument above that Wolff's agent cards to not suggest modifying Buckle's CORBA-based agent mobility system, the Examiner responds by stating "applicant did not claim a CORBA based agent mobility system". The Examiner has misunderstood Applicants' argument. Applicants are arguing that Wolff's agent cards do not suggest modifying Buckle's system, which is a CORBA-based agent

mobility system. As noted above, Wolff's system *requires* physically moving agent cards from one agency unit to another while Buckle, on the other hand, teaches that binary agent code may be sent from one location to another *via ACL messages*. Applicants are arguing that Wolff's teachings that require physically moving devices do not suggest modifying Buckle's system as suggested by the Examiner. **The Examiner has failed to address this argument.**

In response to Applicants' argument above that Wolff's agent card system would not apply to the binary agent code transfer in Buckle's system, the Examiner responds, "Wolff's agent would apply to the binary agent code transfer in Buckle's system because xml is also a type of code or language." However, the fact that XML is used in Wolff's system to describe a class of an agent object or to point to a serialized object or to point to a .class file (Wolff, column 4, lines 24 – 34) does not provide any motivation to modify a system that utilizes CORBA to transfer JAVA byte code. **Additionally, Wolff teaches away from a software based solution for moving state from one location to another, and thus teaches away from any combination with Buckle.** Wolff states, "[s]oftware for transferring state is known, but that requires a software application and then duplicating all of the configuration and data files" (Wolff, column 3, lines 27-30). Wolff also states that his system's "use of state-contained agent cards makes it much easier for an end user to transfer state from one location to another" and additionally states, "[u]nlike [other] approaches the agency unit/agent card approach described herein allows for specifying the access and processing mechanisms in the same package as the data." (Wolff, column 3, lines 32-35). Merely because XML is used in Wolff's system does not overcome the fact that Wolff teaches physically moving agent cards and teaches away from software based mobility solutions.

Also, Buckle's system requires various mechanisms provided by the CORBA platform. Modifying Buckle to use a representation of the an agent would prevent Buckle's system from being able to use the CORBA platform's externalization service (see, page 38, line 28 – page 39, line 4) on which Buckle relies in order to convert an object into a byte stream and one which Buckle also relies on for re-constructing the byte

stream back into an object before storing the reconstituted agent code at location L2. The entire purpose of Buckle's teachings is directed to *moving executable code as binary byte code using CORBA*. Thus, modifying Buckle in view of Wolff, as suggested by the Examiner, would change the basic principle of Buckle's system. Buckle's system would not work as intended if the .xml file as in Wolff was transferred instead of the binary byte code. "If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Additionally, the Examiner has failed to provide a proper motivation to combine Buckle and Wolff. The Examiner states, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Buckle and Wolff's system because Wolff's xml would be the well-known language for streaming data in a distributed system and is enable [sic] for interpretation between applications and organizations." However, Wolff's system does not have anything to do with using streaming data to migrate agent's in a distributed system, as taught by Buckle. As noted above, Wolff teaching agent devices that maintain their state information and that can be physically moved from one agency unit to another. One skilled in the art would not be motivated to modify Buckle's system based on Wolff's teaching, as suggested by the Examiner. Additionally, as noted above, Wolff teaches away from a software based solution for moving state from one location to another, and thus teaches away from any combination with Buckle. Thus, Wolff does not provide any suggestion or motivation to modify the system of Buckle.

In response to Applicants' argument regarding a lack of proper motivation to combine Buckle and Wolff, the Examiner states that "applicant admitted that Buckle and Wolff are combinable". The Examiner is incorrect. **Applicants have never admitted that Buckle and Wolff are properly combinable under 35 U.S.C. § 103(a).** The Examiner also argues, "Buckle and Wolf can be combined because they all teach the mobile agent systems". However, as described above, Buckle and Wolff teach very

different and, in the aspects relied up by the Examiner, systems that teach away from one another. Merely stating that they both teach agent mobility systems does not rebut or overcome Applicants' arguments above. Also, just because the Examiner thinks that the teachings of Buckle and Wolff can be combined does not establish a proper motivation to combine their teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). **Thus, the Examiner has failed to state a proper *prima facie* case of obviousness.**

Furthermore, even if one could combine the teachings of Buckle and Wolff, which Applicants' maintain is improper, the combination would also fail to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state and storing the data representation language representation of the current computation state of the process. As noted above, Buckle teaches that the byte code of an agent, including objects and object states, may be included in a message for transmission from a location L1 to a location L2, and that the agent code may be stored locally on L2 (to enable operation of the agent). Wolff teaches agent cards that maintain state information and may be physically moved from one agency unit to another. Thus, the combination of Buckle and Wolff results in a system that includes two different methods of agent migration (i.e. the CORBA based method of Buckle and the physical movement of cards of Wolff). Additionally, such a combination would not include storing a data representation language representation of the current computation state of a process.

Therefore, for at least the reasons given above, the rejection of claim 1 is not supported by the prior art and withdrawal thereof is respectfully requested. Similar arguments apply in regard to independent claim 51.

In regard to claim 19, contrary to the Examiner's assertion, the cited art does not teach converting a current computation state of a process into a data representation language representation of the current computation state and sending the data representation language representation of the current computation state of the process to a second device. Instead, Buckle discloses a method in which "it is possible to transmit *binary files or byte code* between agents. The byte code sent in a message may include *byte code of an agent* itself. The agent enabling layer utilizes the CORBA Externalization service to record object and object states (i.e. an agent) as a stream of data" (emphasis added, Buckle, page 38, lines 12-14.) Buckle thus teaches that the byte code of an agent, including objects and object states, may be included in a message. Applicants also assert that Buckle teaches the use of ACL messages, which by definition are not data representation language representations of the current computation state (see similar remarks above regarding claim 1).

As discussed above regarding claim 1, Wolff teaches a network appliance system in which agent cards include state information for functionality and which can be mounted in an agency unit (Wolff, Abstract, FIG. 1, column 1, lines 20-29, and column 2, lines 28-36).

The Examiner admits that Buckle fails to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state. Instead, Buckle teaches that the actual byte code of an agent, which is not a data representation language representation, is sent to another location as the content parameter of an ACL message. The Examiner relies upon Wolff, citing column 2, lines 1-10, column 3, lines 25-45, column 4, lines 25-35, column 5, lines 1-8, and column 6, lines 1-5. The first cited passage (column 2, lines 1-10) generally describes how IP address and URL names are used with the Internet. The other cited passages describe various aspects of how Wolff's agent cards work. Wolff teaches that agent cards maintain state for their functionality, but can be physically moved from agency unit to agency unit (Wolff, column 3, lines 6-7).

The Examiner's suggested combination of Buckle and Wolff is improper. Wolff's agent cards do not suggest modifying Buckle's CORBA-based agent mobility system. Wolff teaches that agent cards maintain state for their functionality, but can be moved from agency unit to agency unit (Wolff, column 3, lines 6-7). In other words, Wolff's system requires physically moving agent cards from one agency unit to another. Buckle, on the other hand, teaches that binary agent code may be sent from one location to another via ACL messages. Wolff's system does not involve, nor is Wolff concerned with transferring state information for a process from one device to another, but instead involves allowing devices, that may contain state information from one physical location to another physical location, i.e. from one of Wolff's agency unit to another. Thus, no state information on Wolff's agent card is transferred to another location, as the binary agent code in Buckle's system.

Also, Buckle' system requires various mechanisms provided by the CORBA platform. Modifying Buckle to use a representation of the an agent would prevent Buckle's system from being able to use the CORBA platform's externalization service (see, page 38, line 28 – page 39, line 4) on which Buckle relies in order to convert an object into a byte stream and one which Buckle also relies on for re-constructing the byte stream back into an object (before storing the reconstituted agent code at location L2. Thus, modifying Buckle in view of Wolff, as suggested by the Examiner, would change the basic principle of Buckle's system. "If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (See e.g. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Additionally, the Examiner has failed to provide a proper motivation to combine Buckle and Wolff. The Examiner states, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Buckle and Wolff's system because Wolff's xml would be the well-known language for streaming data in a distributed system and is enable [sic] for interpretation between applications and organizations." However, Wolff's system does not have anything to do

with using streaming data to migrate agent's in a distributed system, as taught by Buckle. As noted above, Wolff teaching agent devices that maintain their state information and that can be physically moved from one agency unit to another. One skilled in the art would not be motivated to modify Buckle's system based on Wolff's teaching, as suggested by the Examiner.

Additionally, Wolff teaches away from a software based solution for moving state from one location to another. Wolff states, "[s]oftware for transferring state is known, but that requires a software application and then duplicating all of the configuration and data files" (Wolff, column 3, lines 27-30). Wolff also states that his system's "use of state-contained agent cards makes it much easier for an end user to transfer state from one location to another" and additionally states, " [u]nlike [other] approaches the agency unit/agent card approach described herein allows for specifying the access and processing mechanisms in the same package as the data." (Wolff, column 3, lines 32-35). Thus, Wolff does not provide any suggestion or motivation to modify the system of Buckle.

Furthermore, even if one could combine the teachings of Buckle and Wolff, which Applicants' maintain is improper, the combination would also fails to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state and storing the data representation language representation of the current computation state of the process. As noted above, Buckle teaches that the byte code of an agent, including objects and object states, may be included in a message for transmission from a location L1 to a location L2, and that the agent code may be stored locally on L2 (to enable operation of the agent). Wolff teaches agent cards that maintain state information and may be physically moved from one agency unit to another. Thus, the combination of Buckle and Wolff results in a system that includes two different methods of agent migration (i.e. the CORBA based method of Buckle and the physical movement of cards of Wolff). Additionally, such a combination would not include storing a data representation language representation of the current computation state of a process.

Therefore, the rejection of claim 19 is not supported by the teachings of the cited art and withdrawal thereof is respectfully requested. Similar arguments apply in regard to independent claims 44 and 61.

The Office Action rejected claims 2-4, 6-8, 27-33, 36-41, 52-53 and 55-56 under 35 U.S.C. § 103(a) as being unpatentable over Buckle in view of Wolff, and further in view of Matsumoto (U.S. Patent 6,763,334).

In regard to claim 27, contrary to the Examiner's assertion, the cited art does not teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state and sending the data representation language representation of the current computation state of the process to a space service for storage. Instead, as discussed above regarding claims 1 and 19, Buckle discloses a method in which "it is possible to transmit *binary files or byte code* between agents. The byte code sent in a message may include byte code of an agent itself. The agent enabling layer utilizes the CORBA Externalization service to record object and object states (i.e. an agent) as a stream of data" (emphasis added, Buckle, page 38, lines 12-14.) Thus, Buckle teaches that the byte code of an agent may be included in a message for transmission from a location L1 to a location L2. Buckle further discloses "the agent is received by a receiving agent at location L2. The agent code, carried by the current parameter is stored locally at the physical resource at location L2, so that the agent *can operate* at physical location L2." (emphasis added, Buckle, page 39, lines 6-8.) Buckle thus teaches that the agent code, and not a data representation language representation of the current computation state, from the message is stored locally on L2 once the message is received on L2. Buckle further teaches the use of content parameters of ACL messages and specifically states that it due to the fact that the content parameter is not restricted in format that allows the transmission of binary files or byte code (Buckle, page 38, lines 10-12). Thus, Buckle is clearly teaching the transfer of binary data (agent code) and not the sending of the data representation language representation of the current computation state of a process.

In contrast to the Examiner's assertion, Buckle fails to teach or suggest a space operable to store documents including data representation language documents in the distributed computing system. The Examiner cites page 39, lines 1-10 where Buckle describes how a CORBA based serialization of an agent may be received by a device, reconstituted back into actual agent code and stored at location L2. However, Buckle's devices and destinations are not spaces operable to store documents. Instead, Buckle teaches moving agents, which are not documents.

Additionally, Buckle fails to teach or suggest a space service operable to store and retrieve documents to the space for processes in the distributed computing environment, as the Examiner contends. The Examiner again cites page 39, lines 1-10 of Buckle and argues that Buckle's agent can operate at location L2. However, the cited passage and the Examiner's reference to an agent operating at location L2, have no relevance to a space service operable to store and retrieve documents to the space for processes in the distributed computing environment. Buckle does not mention any space service and does not describe any of this agents or devices as operable to store and retrieve documents to a space for processes in the distributed computing environment.

Furthermore, the Examiner argues both that Buckle does teach a space service and also argues that Buckle does not teach such a service (See, Office Action, page 13, lines 2-3 and page 14, lines 11-13). It is clearly improper to rely on two conflicting interpretations of the prior art.

The Examiner admits that Buckle fails to teach or suggest converting a current computation state of a process into a data representation language representation of the current computation state. Instead, Buckle teaches that the actual byte code of an agent, which is not a data representation language representation, is sent to another location as the content parameter of an ACL message. The Examiner relies upon Wolff, citing column 2, lines 1-10, column 3, lines 25-45, column 4, lines 25-35, column 5, lines 1-8, and column 6, lines 1-5. The first cited passage (column 2, lines 1-10) generally describes how IP address and URL names are used with the Internet. The other cited

passages describe various aspects of how Wolff's agent cards work. Wolff teaches that agent cards maintain state for their functionality, but can be physically moved from agency unit to agency unit (Wolff, column 3, lines 6-7).

The Examiner's suggested combination of Buckle and Wolff is improper. Wolff's agent cards do not suggest modifying Buckle's CORBA-based agent mobility system. Wolff teaches that agent cards maintain state for their functionality, but can be moved from agency unit to agency unit (Wolff, column 3, lines 6-7). In other words, Wolff's system requires physically moving agent cards from one agency unit to another. Buckle, on the other hand, teaches that binary agent code may be sent from one location to another via ACL messages. Wolff's system does not involve, nor is Wolff concerned with transferring state information for a process from one device to another, but instead involves allowing devices, that may contain state information from one physical location to another physical location, i.e. from one of Wolff's agency unit to another. Thus, no state information on Wolff's agent card is transferred to another location, as the binary agent code in Buckle's system.

Also, Buckle' system requires various mechanisms provided by the CORBA platform. Modifying Buckle to use a representation of the an agent would prevent Buckle's system from being able to use the CORBA platform's externalization service (see, page 38, line 28 – page 39, line 4) on which Buckle relies in order to convert an object into a byte stream and one which Buckle also relies on for re-constructing the byte stream back into an object (before storing the reconstituted agent code at location L2. Thus, modifying Buckle in view of Wolff, as suggested by the Examiner, would change the basic principle of Buckle's system.

Please also see arguments above regarding the rejections of claims 1 and 19.

The Examiner admits that Buckle in view of Wolff, fails to teach or suggest a space service operable to store and retrieve documents to the space for processes in the distributed computing environment (however, as noted above, the Examiner also argues that Buckle

does teach such a space service). The Examiner proposes modifying the combination of Buckle and Wolf, which Applicants' maintain is improper, with the teachings of Matsumoto. Matsumoto teaches a method for arranging commercial advertisements on a network for a potential media owner or affiliate to sell ad space on a network. In Matsumoto's system, an advertiser's advertisement is placed on an affiliate's web site and the number of user responses to the advertisement is used to determine payment for the ad space. Matsumoto's system for providing commercial advertisements has nothing to do with either Buckle or Wolff's teachings, either separately or in combination. Matsumoto is not concerned with mobile agents and is also not concerned with a space service operable to store and retrieve documents to a space for processes in a distributed computing environment. Matsumoto's system only allows web-based advertisements to be installed on a web page. The Examiner fails to cite any passage of Matsumoto, and Matsumoto fails to mention, anything regarding such a space service.

The Examiner cites column 6, lines 55-65 and column 7, lines 5-10 and 50-60 of Matsumoto. The first cited passage refers to an offer web page and an information web page that provide information usable to allow an affiliate to decide where to place an advertisement. The second cited passage describes a confirmation notice that includes information regarding the place of an advertisement on a web page in Matsumoto's system. The third cited passage describes an arrangement module that allocates the actual space for the ad. None of the cited passages have anything to do with a space service operable to store and retrieve documents to a space for processes in the distributed computing environment. Matsumoto's ad space is not a space to which documents are stored and retrieved by processes in a distributed computing environment. Instead, Matsumoto's ad space is merely a web page where commercial advertisements are place for a fee.

Therefore, the rejection of claim 27 is not supported by the teachings of the cited art and withdrawal thereof is respectfully requested.

In regard to claim 41, similar arguments regarding Buckle and Wolff, as discussed above for claim 1, apply to the rejection of claim 41 with equal force.

Furthermore, contrary to the Examiner's assertion, the cited art does not teach or suggest generating an advertisement for the stored data representation language representation, wherein the advertisement comprises information to enable access to the stored data representation language representation.

The Examiner cites column 6, lines 25-35 and column 7, lines 50 –60 of Matsumoto. However, these portions of Matsumoto only describe commercial advertisements placed on web pages and have no relevance to an advertisement for a stored data representation language representation. Nowhere does Matsumoto mention anything regarding an advertisement for a stored data representation language representation of a current computation state of a process. Matsumoto is only concerned with commercial advertisements – not advertisements for representations of current computation states of processes. Additionally, Matsumoto does not teach or suggest anything about an advertisement that comprises information to enable access to a stored data representation language representation. The Examiner cites column 6, line 50 – column 7, line 20, where Matsumoto describes how an affiliate and an advertiser negotiate for placing a commercial advertisement on a web page. However, the cited passage has no relevance to an advertisement comprising information to enable access to a stored data representation language representation of a current computation state of a process. Additionally, Matsumoto's ads do not include information to enable access to a stored data representation language representation of a current computation state. Neither Buckle nor Wolff overcomes any of the above noted deficiencies of Matsumoto regarding generating an advertisement for the stored data representation language representation of the current computation state of the process.

Therefore, the rejection of claim 41 is not supported by the teachings of the cited art and withdrawal thereof is respectfully requested.

The Examiner newly rejected claims 9 and 57 as being unpatentable over Buckle in view of Wolf, and further in view of Matsumoto and Orbanes (U.S. Patent 6,751,620).

Further in regard to claim 9, similar arguments regarding Buckle and Wolff, as discussed above for claim 1, apply to the rejection of claim 9 with equal force. Additionally, similar arguments regarding Buckle, Wolff and Matsumoto, as discussed above for claim 41, also apply to the rejection of claim 9.

In further regard to claim 9, the cited art also fails to teach or suggest wherein the advertisement for the data representation language representation of the current computation state of the process is stored to a space using a space service, wherein the space service is operable to store documents including advertisements in the distributed computing environment, and wherein the space service is operable to store and retrieve documents to the space for processes in the distributed computing environment. The Examiner cited column 20, lines 35-55 of Orbanes. Orbanes teaches a method for presenting information to a user in a way that mimics physical paradigms, such as financial, educational, sports, media, retails or other paradigms, to provide an intuitive mechanism for the user to view, search through and interact with displayed information in an unrestricted manner.

At the Examiner's cited passage, Orbanes is concerned with a user searching and viewing commercial advertisements, which are very different from an advertisement for a data representation language representation of a current computation state of a process. Orbanes does not teach or suggest storing an advertisement for a data representation language representation of a current computation state of a process to a space using a space service operable to store and retrieve documents to the space for processes in the distributed computing environment. In contrast, Orbanes teaches using a user adjustable viewing perspective to present information to a user according to a selected physical paradigm, such as financial, educational, governmental, sports, media, etc. The Examiner cites column 20, lines 35 – 55 where Orbanes describes virtually transporting a user to a virtual space that contains data objects related to a user-selected advertisement.

However, the hierarchical data object view of Orbanes has no relevance to storing an advertisement for a data representation language representation of a current computation state of a process to a space using a space service. The Examiner has not cited any passage regarding storing an advertisement to a data representation language representation of a current computation state of a process. Nor does Orbanes teach or suggest anything about storing representations of computational states of processes.

Applicants note that the rejection is also improper because the Examiner has not shown that Orbanes qualifies as a prior art reference. The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that Orbanes qualifies as a prior art reference, the Examiner has not met this burden of proof and the rejection is improper. More specifically, the Orbanes patent was filed on February 14, 2001, after Applicants' filing date of September 15, 2000. Orbanes does claim the benefit of two provisional applications filed February 14, 2000. However, the February 14, 2000 filing date can only be used as Orbanes' 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the Orbanes patent and one of the provisional applications. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application, it is unclear whether the material in Orbanes relied upon by the Examiner was actually present in Orbanes' provisional application. In fact, a quick scan of the provisional applications shows that they differ greatly from the Orbanes patent. Therefore, Applicants request that the Examiner show that the subject matter upon which the Examiner is relying to reject Applicants' claims is also present in one of Orbanes' provisional applications filed February 14, 2000. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, the Orbanes patent is not entitled to the February 14, 2000 date as a section 103(a) prior art date unless at least one claim of the Orbanes patent is supported (under 35 U.S.C. § 112) in one of the provisional applications. Under 35 U.S.C. 119(e)(1), a patent is not entitled to its provisional application's filing date as a prior art

date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in one of the provisional applications. The rejection is improper unless the Examiner can show that Orbanes' published application has the necessary claim support in one of the provisional applications to be entitled to the provisional application's filing date as its § 103(a) prior art date. *See also* M.P.E.P. § 2136.03(IV).

Since the Examiner has not shown that <u>both</u> of the above requirements have been meet for Orbanes to qualify as prior art, the rejection is improper.

For at least the reasons above, the rejection of claim 9 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks apply to claim 57 as well.

The Office Action also rejected claim 11 as being unpatentable over Buckle in view of Wolf, and further in view of Jagannathan (U.S. Patent 6,496,871), claim 34 as being unpatentable over Buckle in view of Wolf, and further in view of Matsumoto and Jagannathan, claims 12, 22 and 35 as being unpatentable over Buckle in view of Wolf, and further in view of Edward ("Core Jini" pages 405-410). Applicants traverse these rejections for at least the reasons given above in regard to the independent claims.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

<u>Allowed/Allowable Claims</u>:

Claims 23, 42, 43, and 47-49 are allowed. Claim 15 is only objected to. Claim 64 should also be in condition for allowance.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-47200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Petition for Extension of Time

☐ Notice of Change of Address

☐ Other:

Respectfully submitted,

Robert C. Kowert
Reg. No. 39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

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